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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,469	01/02/2002	Jennifer Bryman	05793.3054-00	5583
22852 7590 11/26/2008 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				
EXAMINER CHAMPAGNE, DONALD				
ART UNIT 3688		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/032,469

Applicant(s)

BRYMAN ET AL.

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3 April 2008 has been entered.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to nonstatutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter.
4. Here claims 1-21 fail to meet the above requirements because the claims fail to tie in another statutory class of invention. The claims are limited to a "partnership check" but that is at best printed matter, which is non-functional descriptive material and not given patentable weight (MPEP § 2106.01 and 706.03(a)A).
5. Applicant is hereby put on notice that *In re Bilski*, CAFC case 2007-1130 decided on 30 October 2008, appears to emphasize the importance of a *particular* apparatus (pp. 10-13). The CAFC reasoned (p. 13), "However, in *Benson*, the limitations tying the process to a computer were not actually limiting because the fundamental principle at issue, a particular

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algorithm, had no utility other than operating on a digital computer." It is not certain that the instant invention would be statutory even if limited to a general purpose digital computer.

Claim Rejections - 35 USC § 102 and 35 USC § 103

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-9, 12-16 and 18-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Schulze, Jr. (US005483049A).
9. Schulze, Jr. teaches (independent claims 1, 13, 18 and 22) a method and system for issuing/providing partnership checks (redemption *checks 48*), the method (as expressed by claim 1) comprising:

analyzing a group of merchants based on a set of merchant qualification criteria, wherein the set of merchant qualification criteria is analyzed using a statistical analysis method that considers at least one factor associated with each merchant of the group of merchants (*geographic region*, col. 18 lines 34-39);

identifying one merchant (*the retail sales store*, col. 2 lines 66-67) of the group of merchants for associating with partnership checks (*coupon exchange coupons*, col. 2 line 66) based on the analysis;

creating a first partnership check (*coupon exchange coupon 40*, col. 3 line 60 to col. 4 line 5) such that the first partnership check/*coupon exchange coupon 40* includes a routing

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number (*consumer identification code*, col. 8 lines 30-34 and para. xx below) and is redeemable with the one merchant (col. 2 line 65 to col. 3 line 4);

associating the first partnership check/*coupon exchange coupon 40* with a customer based on an account number associated with the customer (*consumer identification code*, col. 8 lines 30-34); and

sending the first partnership check to the customer based on the account number (col. 2 lines 19-20).

10. For claim 13, forming a "value sharing relationship" with at least one *retailer* (merchant) is taught at col. 1 line 62 to col. 2 line 24). For claim 18, "generating a list of prospective merchants" is inherent (col. 18 line 38 teaches *retail outlets*, which reads on a list of prospective merchants; that said list exists must mean that it was generated); "generating/analyzing a list of prospective customers" is taught at col. 6 lines 58-67 and col. 3 line 1).
11. The following claim language is non-functional descriptive material and was not given patentable weight (MPEP § 2106.01):

"wherein the value sharing relationship allows the issuer and the at least one merchant to share the value provided by use or issuance of at least one of the partnership checks" (e.g., claim 13 lines 5-7).

In the sense used in the patent law (35 USC 101), said "relationship" is not functional because it is neither "tied to a particular apparatus" nor "operates to change materials to 'a different state or thing'" (*IN RE COMISKEY*, CAFC 2006-1286, September 2007).

12. Note on interpretation of claim terms - Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes ... but does not

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include ...". An example does not constitute a "clear definition" beyond the scope of the example.

13. The instant application contains no such clear definition for the phrase "routing number". The phrase is explained at para. [0034] of the published application (US 20030126011A1) as an example kind of tracking code. As noted above, that does not qualify as a clear definition. Hence, in the instant case, the examiner is required to give the term "routing number" its broadest reasonable interpretation, which the examiner judges to be any code used for routing the subject partnership check/*coupon exchange coupon* **40**. The *consumer identification code* taught by Schulze, Jr. (col. 8 lines 30-34) reads on that.
14. The instant application contains no such clear definition for the phrase "statistical analysis". The phrase is supported by example usage (e.g., at para. [0045] of the published application (US 20030126011A1), but does not meet the requirements for a "clear definition." In the instant case, the examiner is required to give the term "statistical analysis" its broadest reasonable interpretation, which the examiner judges to be any mathematical consideration of information. That includes the use of set logic, which is taught inherently by Schulze, Jr. (col. 18 lines 34-39).
15. Schulze, Jr. also teaches at the citations given above claims 2, 5, 9, 12, 20 and 25.
16. Schulze, Jr. also teaches claims 3, 4, 23 and 24 (col. 18 lines 19-24 and 34-39); claim 6-8, 14-16, 21 and 26 (Last sentence of abstract and col. 2 lines 4-52); and claim 19 (*database 228*, col. 9 line 26-29).
17. Claims 10, 11 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schulze, Jr. (US005483049A). Schulze, Jr. does not teach inserts (claims 10 and 17) with the mailed coupons/checks and an incentive chosen so as to maximize profit (claim 11). Official notice is taken (MPEP § 2144.03) that both of these limitations were in common use, and therefore obvious to one of ordinary skill in the art, at the time of the instant invention.
18. Traverse of the taking of Official Notice - Applicant has traversed the examiner's taking of official notice (pp. 15-18 of the arguments filed on 9 April 2007). However, applicant has not provided adequate information or argument so that *on its face* it creates a reasonable doubt regarding the circumstances justifying the official notice (MPEP § 2144.03). An effective traverse must be based on alleged evidence, not mere denial. Applicant could, for

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example, have gotten testimony from an economics professor saying that is it not notoriously common to try to maximize profit. Or applicant could have offered testimony from a mailing firm testifying that it is not notoriously common for checks to be sent with informational inserts. The examiner would than have been compelled to produce counter evidence in order to maintain the tasking of official notice. But applicant submitted no such evidence. Therefore, the presentation of a reference to substantiate the official notice is not deemed necessary. The examiner's taking of official notice is maintained.

Response to Arguments

19. Applicant's arguments filed on 14 October 2008 have been fully considered but they are not persuasive. The arguments have been considered in the revised rejection.

Suggestion of Further Limitation

20. The instant application discloses a "bank routing number" (para. [0034] of the published application (US 20030126011A1). Schulze, Jr. does not teach or suggest that *coupon exchange coupon 40* includes a "bank routing number".¹ Hence the instant rejection of claims 1-9, 12-16 and 18-26 under 35 U.S.C. 102(b) as being anticipated by Schulze, Jr. would be overcome by amending "routing number" to "bank routing number". However, allowance could be justified only by the results of a further search of the prior art,
21. Whereas "routing number" would be understood by one of ordinary skill in the art to be a very general term for a index by which an instrument can be routed (para. 13 above), a *bank routing number* would be understood by one of ordinary skill in the art to be the common nine-digit number used to route instruments between banks, and also known as the *ABA routing number* and *routing transit number (RTN)*. See the two Google searches made of record herewith.

Conclusion

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 9:30 AM to 8 PM ET, Monday to Thursday. The

¹ To avoid confusion, it is noted that Schulze, Jr. does teach (col. 10 lines 9-17) *check 48* includes a bank routing number.

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examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.

23. The examiner's supervisor, James W. Myhre, can be reached on 571-272-6722. The fax phone number for all *formal* fax communications is 571-273-8300.
24. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
25. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

23 November 2008

/Donald L. Champagne/
Primary Examiner, Art Unit 3688